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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/091,930	03/05/2002	Edmond Ken Lee	M-12577 US	7076

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BINGHAM, MCCUTCHEN LLP  
THREE EMBARCADERO, SUITE 1800  
SAN FRANCISCO, CA 94111-4067

EXAMINER

SANDY, ROBERT JOHN

ART UNIT	PAPER NUMBER
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3677

DATE MAILED: 12/02/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/091,930

Applicant(s)

LEE ET AL.

Examiner

Robert J. Sandy

Art Unit

3677

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09 September 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-10 and 13-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 8 and 14-17 is/are allowed.
- 6) ☒ Claim(s) 1-7 and 9-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

THIS ACTION IS RESPONSIVE TO THE AMENDMENT FILED 9 SEPTEMBER 2003.

Claims 11, 12, and 18-20 were canceled.

Claims 1, 6 and 13 were amended.

Claims 1-10 and 14-17 are pending.

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 2, 3, 6, 7 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Tucker (U.S. Patent No. 5,332,090). Tucker ('090) discloses a clip (holder 20) comprising: a body with a first aperture (42) shaped to receive a portion of a golf club (see Fig. 1, circular-shape of opening 42 is structurally capable to receive a shaft of a golf club having a circular-shaped cross-section) ; and a second aperture (second aperture defined between legs 32 and 34); (concerning claim 2) a fastener (31a) adapted to be inserted at least partially through the second aperture for fastening a towel to the clip; (concerning claim 3) the fastener is removably fastened; (concerning claim 6) the first aperture is adapted to receive a shaft of said golf club; (concerning claim 7) bendable tongs (44, 46) surrounding the first aperture; (concerning claim 9) at least a portion of said body is made of plastic ("plastic", column 3, line 18).

3. Claims 1, 2, 4, 5, 6, 7, 9, 10 and 13 is rejected under 35 U.S.C. 102(b) as being anticipated by Evans (U.S. Patent No. 5,671,515). Evans ('515) discloses a clip (10) to attach a towel, the clip comprising: a body (members 11 and 12) with a first aperture (looped portion 40

Art Unit: 3677

of member 12 as shown in Fig. 9) shaped to receive a portion of a golf club and a second aperture (defined between lips 13 and 15 of member 11) to receive a towel (23);

(concerning claim 2) a fastener (locking rivet 14) is adapted to be inserted at least partially through the second aperture for fastening the towel to the clip;

(concerning claim 4) the fastener is a rivet (locking rivet 14);

(concerning claim 5) a towel (23) is inserted into the second aperture and fastened to the clip;

(concerning claim 7) bendable tongs surrounding said first aperture (i.e., the loop 40 is provided by bending clasp 10);

(concerning claim 9) at least a portion of said body is made of plastic (i.e., "plastic material"; column 2, line 57); and

(concerning claim 10) a towel (23) attached to said clip by a fastener (rivet 14) inserted through said second aperture.

Concerning claim 13, Evans ('515) discloses a clip (10) to attach a towel to a golf club, the clip comprising: a body (members 11 and 12) with a first aperture (looped portion of member 12 as shown in Fig. 9) adapted to receive a portion of a golf club and a second aperture ("rivet-receiving aperture 16" of member 11; column 2, line 62) adapted to receive a fastener (locking rivet 14) situated to attach a towel (23) to the clip.

### ***Response to Arguments***

Regarding the request for changing the first named inventor, applicant had notified the Examiner in a subsequent phone call informing to disregard the request.

Applicant's arguments filed 9 September 2003 pertaining to Evans (U.S. Patent No. 5,671,515) not disclosing or suggesting the limitation of "a body having an aperture shaped for receiving a portion of a golf club" have been fully considered but they are not persuasive. Since Evans ('515) structurally meets the claim limitations as set forth in the rejection in section three of the Office action, Evans is not required to explicitly disclose the intended use of applicant claimed clip, wherein applicant's intended use is "to attach a towel to a golf club", wherein the "first aperture is shaped to receive a towel". Since the device of Evans ('515) structurally meets

Art Unit: 3677

the claim limitations, then the device of Evans ('515) is structurally capable of performing the intended use of applicant's claimed clip.

Function Follows Form In an Anticipation Rejection: In re Schreiber, 128 F.3d 1473, 44 USPQ2d 1429 (Fed. Cir. 1997)(aff'g PTO), the court's decision illustrated the risks an applicant takes by defining the claimed invention in functional language. The Office rejected claims directed to a funnel top for a popcorn container as anticipated by a funnel top for an oil can, noting that the oil funnel could perform the same function of dispensing popcorn. Schreiber argued that an oil can funnel was not a proper reference for rejecting a popcorn dispensing funnel, since they are in completely different fields of endeavor. The court affirmed the Office, noting that analogous art is not a consideration for anticipation. Since the oil can funnel was inherently capable of dispensing popcorn and all the other limitations were met, the anticipation rejection was proper.

#### *Allowable Subject Matter*

Claim 8 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The objection to claim 3 as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims, is withdrawn in view of the new grounds for rejection necessitated by applicant's amendment.

Claims 14 - 17 are allowed over the prior art of record, as indicated in the prior Office action mailed 24 June 2003.

#### *Conclusion*

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

Art Unit: 3677

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert J. Sandy whose telephone number is (703) 305-7413. The examiner can normally be reached on Monday through Friday from 7:30 AM to 4:00 PM (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J. J. Swann, can be reached on (703)306-4115.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-2168. Technology Center 3600 Customer Service is available at 703-308-1113. General Customer Service numbers are at 800-786-9199 or 703-308-9000. Fax Customer Service is available at 703-872-9325.

Any response to this action should be mailed to:

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

or faxed to: 703-872-9306, for formal communications for entry.

For informal or draft communications, please label "PROPOSED" or "DRAFT" and fax to: 703-746-3767, and notify the examiner by telephone that a fax has been sent.

Hand-delivered responses should be brought to Crystal Park Five, 2451 Crystal Drive, Arlington, Virginia, Seventh Floor (Receptionist suite adjacent to the elevator lobby).



**ROBERT J. SANDY**  
**PRIMARY EXAMINER**